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10/587,432

07/27/2006

Masahiro Oho

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WASHINGTON, DC 20006

EXAMINER

QAYYUM, ZESHAN

ART UNIT

PAPER NUMBER

3685

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-----------------------------------|--|
| Office Action Summary | Application No. 10/587,432 | Applicant(s) OHO ET AL. | |
| | Examiner ZESHAN QAYYUM | Art Unit 3626 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/27/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of claims

1. Claims 1-25 have been examined.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 20, 24 and 25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
3. Claim 20 is directed to method for managing license information. As the claims are not sufficiently tied to an apparatus, such as a computer, and/or do not transform the underlying subject matter to a different state the claimed method is non-statutory and therefore rejected under 35 U.S.C. 101. (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)).
4. Claims 24 and 25 are directed to record medium. It stores nonfunctional descriptive material. However it has been held when nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. ((See MPEP 2106.01) (*Diamond v. Chakrabarty*, 447 U.S.303, 206 USPQ 193 (1980); *Diamond v. Diehr*, 450 U.S. 175, 209 USPQ 1 (1981)).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.
7. For the examination purpose The Examiner interprets usage condition as the number of time the software can be used and range as the time period when content can be used.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
9. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wyman (US 5260999).

10. With respect to claims 1-25, Wyman discloses: a first right management device provided for said content provider (See fig 1, part 28) a second right management device (See fig 1, part 25 and column 10, lines 39-50) a license information generation unit (See column 10, lines 39-50) terminal device (i.e. user device) (See fig 1, part 16, column 9, lines 40-42) a range designation obtainment unit, a usage condition judgment unit, a validation unit (column 12, lines 16-22, column 15, lines 42-56) a transmission unit (see column 10, lines 45-48) a reception unit operable to receive the license information from said second right management device (See column 11, lines 10-11, 41-44 and fig 1, part 10) and an issue unit (See column 12, lines 60-68) a content key obtainment unit (See column 14, lines 40-48). With respect to “operable to...” (i.e. capable of being used or desirable to use) it is intended use of the units above. Therefore it has been held while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone -MPEP 2114; In re Swineheart, 169 USPQ 226; In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997). In addition with respect to “when clause”, according to MPEP “Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. (MPEP 2106 II C)” therefore the language “when” will not distinct the claims from prior art.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Downs (US 6226618) teaches Electronic content delivery system.
- Abburi (US 7203966) teaches Enforcement architecture and method for digital rights management system for roaming a license to a plurality of user device.
- Higashi (US 20020107806) teaches content usage management system and content usage management method.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ZESHAN QAYYUM whose telephone number is (571)270-3323. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->

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direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Z. Q./

Examiner, Art Unit 3626

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685